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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,496	10/22/2001	Timothy I. Moodycliffe	J 3317	2275

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EXAMINER	
WEBB, GREGORY E	
ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/007,496	MOODYCLIFFE, TIMOTHY I.	
	Examiner	Art Unit	
	Gregory E. Webb	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *110804*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 13-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The following action is in response to the applicant's amendments and arguments filed 11/8/04.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 13-20 remain rejected under 35 U.S.C. 102(e) as being anticipated by Allison et al (US 6,478,830).

4. Claims 13-20 remain rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al (US 3,969,087).

Response to Arguments

5. Applicant's arguments filed 11/8/04 have been fully considered but they are not persuasive.

6. The applicant has amended the claims to further define the composition as being a "spray product" and removed the language "suitable for dispensing through a spray mechanism."

7. The applicant argues that the prior art fails to teach or suggest using the compositions of the prior art specifically for spraying. The applicant states on page 8, line 12 that "the purpose of such combination is totally distinct from the purpose of the present invention."

8. Thus the applicant's arguments are based on the purpose the compositions are intended to be used and not the material ingredients required by the composition. In fact the applicant

admits that the prior art compositions teach the combination of amino acids and mineral oil and thus meets the applicant's claimed material limitations (see page 8, line 10).

9. It should be noted that intended use recitations and other types of functional language cannot be entirely disregarded. However, in composition claims, intended use must result in structural difference between the claimed invention and the prior art in order to patentable distinguish the claimed invention from the prior art (see MPEP 2111.02). Furthermore, applicant may not rely upon the preamble to distinguish his claimed composition from that of the prior art, where the preamble does not constitute a limitation of a claim when it states a purpose or intended use (see Loctite Corp. V. Ultraseal Ltd., 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985)). As the prior art teaches each of the material limitations such intended use limitations as "sprayable" would be clearly inherent to those prior art compostions.

10. The term "sprayable" is for the most part defining the purpose of use as stated by applicant (see page 8, line 12). The term sprayable however does imply that the compositions are at least in a liquid form. Such forms of matter are afforded some patentable weight. However in the instant case all the prior art references teach liquid compositions. The examiner argues that any liquid no matter the viscosity is able to flow (by definition of viscosity). Any flowing liquid can be forced through a small aperture (for example icing for a cake can be sprayed through small nozzles) and thus be "sprayed." Forcing liquids through a small aperture would meet the definition of sprayable. Thus any flowable composition would also be a sprayable composition. As the prior art compositions are flowable, at least at temperatures above ambient, they are by definition also sprayable.

11. The examiner finds support for this argument in the following definition of the verb "to spray." (see dictionary.com):

> *v.* **sprayed, spray·ing, sprays**
> *v. tr.*
> 1. To disperse (a liquid) in a mass or jet of droplets.
> 2. To apply a spray to (a surface).
>
> *v. intr.*
> 1. To discharge sprays of liquid.
> 2. To move in the form of a spray.

12. The verb "spray" does not require a certain viscosity of fluid only that the material be in a fluid form. Thus broadly interpreted the term "sprayable" only implies that the composition is liquid. It does not require the prior art to specifically teach "sprayable" but only requires that the prior art teach liquid compositions.

13. Thus the examiner is not convinced by the applicant's arguments regarding intended use and the sprayability of the prior art composition. The examiner has found each of the applicant's claimed material limitations and thus the prior art is in clear anticipation of the instant claims.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

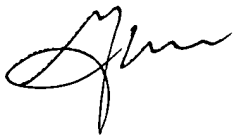
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory E. Webb
Primary Examiner
Art Unit 1751

gw